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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,972

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Jean-Claude Sarfati

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OSHA LIANG L.L.P.  
1221 MCKINNEY STREET  
SUITE 2800  
HOUSTON, TX 77010

EXAMINER

NGUYEN, PHILLIP H

ART UNIT

PAPER NUMBER

2191

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/08/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/529,972	SARFATI ET AL.	
	Examiner	Art Unit	
	Phillip H. Nguyen	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/31/05</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the original filing date of 10/02/2003. Claims 1-10 are pending and have been considered below.

### ***Drawings***

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 6-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are directed to software per se ("integrated software"), lacking storage on a medium, which enables any underlying functionality to occur.

**Claim Rejections - 35 USC § 112**

5. Claims 1, 2, 3, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding to 1, 2, and 3, the phrase "said first integrated software/first integrated software" is unclear to Examiner as to whether Applicant refers to "integrated software" or to a different one, which called "first integrated software". Applicant is required to be more specific.

Regarding to claim 6, the phrase "said software" is unclear to Examiner as to whether Applicant refers to "integrated software", "first software", "application software" or "verification software". Applicant is required to clarify.

*claims 4-5 depend on claim 1 and 2 and suffer the same deficiency.  
claim 7-10 depend on claims 2-5 and suffer the same deficiency.*

**Claim Rejections - 35 USC § 102**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 4-7, 9, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Parkkinen (United States Patent No.: US 6,675,201 B1).

As per claim 1:

Parkkinen discloses a method for authenticating software downloaded in a terminal, said method comprising:

- a step for authenticating by certificate said downloaded software by means of software integrated in said terminal (**"after the terminal has downloaded the software, it checks the authenticity of the software in step 310 by calculating, similarly as at the server, the check sum of the downloaded software and the certificate attached to the software"** Col 5, line 29-32), characterized in that it also comprises a step for authenticating by certificate, during execution of said downloaded software (**"the terminal then decrypts the encrypted electronic signature attached to the software"** Col 5, line 33-34, **this means, in order to decrypt the encrypted electronic signature, the software is executed**), said first integrated software by means of an authentication software module associated with said downloaded software (**it is inherent in Parkkinen's approach in order to perform the authenticating process**).

Note: Applicant recites the phrase "for" in the preamble and the body of the claim, which indicates intended use, as such does not carry patentable weight. The limitations following the phrase "for" describe only intended use but not necessarily required functionality of the claim.

As per claim 2:

Parkkinen discloses the method as in claim 1 above; and further discloses:

- in which the first integrated software authenticates the downloaded software by means of an authentication library ("**a collection means 206**" Col 4, line 1) and a first certificate ("**certificate attached to the software**" Col 5, line 32), in which the first integrated software and the authentication library form a first part of write-protected memory (**see FIG. 4 and texts which further expands their feature** Col 5, line 44-65), and in which the downloaded software and the first certificate form a second part of the loadable memory (**the certificate and the software is formed a second part of the loadable memory after they being downloaded to the terminal**).

As per claim 4:

Parkkinen discloses the method as in claim 1 above; and further discloses:

- in which these two successive authentications take place on initialization (**It is inherent in Parkkinen's approach since terminal calculates the checksum and certificate to compare the signature with the reference signature**, Col 5, line 35-42).

As per claim 5:

Parkkinen discloses the method as in claim 2 above; and further discloses:

- in which the second part is downloaded (**"terminal has downloaded the software" Col 5, line 29, the second part includes downloaded software and the certificate embeds in the downloaded software**).

As per claim 6:

Parkkinen discloses the method as in claim 1 above; and further discloses:

- integrated software comprising a first write-protected memory part, including first software (**"the software needed by the terminal are stored into the memory" Col 4, line 44-45**), an authentication library (**"a collection means 206" Col 4, line 1**), and a second certificate (**second certificate is inherent in Parkkinen's approach in order to perform the comparison**), and a second memory part including application software (**"the downloaded software" Col 5, line 32**), a first certificate (**"the certificate attached to the software" Col 5, line 32**) and verification software (**terminal includes a software/program/module uses to check the authentication and signature attached to the software**), for executing the steps of the method as claimed in claim 1, when said software is executed on a computer (**the authenticity is taking place at the terminal, therefore, the software is executed on the terminal/computer**).

As per claim 7, 9, and 10:

Recite the same limitations as recited in claim 6, and therefore, have been addressed in connection with the rejection set forth to claim 6 above.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parkkinen (United States Patent No.: US 6,675,201 B1).

As per claim 3:

Parkkinen discloses the method as in claim 2 above; and further discloses:

- in which the first part also includes a second certificate (**It is inherent in order to perform comparison**), in which the second part also includes verification software (**terminal includes a software/program/module to verify the signatures**).

Parkkinen does not explicitly discloses:

- in which once the downloaded software has been authenticated, the verification software authenticates the first integrated software by means of the authentication library and the second certificate.



However, it would have been obvious to one having one ordinary skill in the art at the time the invention was made to modify Parkkinen's step to include authenticating the first integrated software. One of ordinary skill in the art would have been motivated to perform this step because it helps preventing software downloading from a disturber.

As per claim 8:

Recites the same limitations as recited in claim 6, and therefore, has been addressed in connection with the rejection set forth to claim 6 above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip H. Nguyen whose telephone number is (571) 270-1070. The examiner can normally be reached on Monday - Thursday 10:00 AM - 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2191

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PN  
02/01/2007

  
WEI ZHEN  
SUPERVISORY PATENT EXAMINER